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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,116	12/09/2003	Kazuhiko Isogawa	0754-0196P	4333
2292	7590	06/01/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			BUTTNER, DAVID J	
			ART UNIT	PAPER NUMBER

1712

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,116

Applicant(s)

ISOGAWA ET AL.

Examiner

David Buttner

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 rejected under 35 U.S.C. 102(b,e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Iwami '667.

Iwami golf balls coated with polyesterpolyol + polyisocyanate paints. The polyesterpolyol can have MW's and hydroxyl numbers within applicant's range (col 7 line 1-15). Although the paint is not aqueous, the final painted ball is the same regardless what carrier was used. The carrier (solvent or water) has evaporated from the final ball. The paint can have a thickness of 5-20 microns (col 3 line 16).

Claims 4,5 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohira '410 optionally in view of Maruoka '851.

Ohira produces aqueous golf ball paints of urethanepolyol and polyisocyanate. The urethanepolyol has a hydroxyl number of 100-300mgKOH/g (col 2 line 4). Applicant's claim to a hydroxyl number just below 100mgKOH/g is so close to 100mgKOH/g that the two would be expected to have the same properties. The two values are obvious over one another (see MPEEP 2144.05 I; Titanium Metals v Banner

227USPQ773). Also note that Ohira's exemplifies comparison examples at 75 and 64mgKOH/g (col 8 line 26,57). Ohira does not report the MW of the urethanepolyol.

It is known that urethanepolyols of 4000-9000 MW are favorable in golf ball paints (see Maruoka's abstract). It would have been obvious to ensure that Ohira's urethanepolyol has an optimal MW for the advantages explained by Maruoka.

Claims 1-5 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Ohira '410 in view of Maruoka '851 in further view of Iwami '667.

Ohira/Maruoka do not place any limitations on the paint thickness in the final ball.

Iwami (col 3 line 16) teaches thicknesses of 5-20 microns are conventional. It would have been obvious to ensure conventional paint thicknesses when coating Ohira's paint on the golf ball.

Claims 4-9 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Patzschke '822.

Patzschke exemplifies (#10) an aqueous coating composition of polyesterpolyol and polyisocyanate. The polyesterpolyol had a hydroxyl number of 82 (col 11 line 23) diluted with butyl alcohol (ie ethyleneglycol butylether). The preferred MW's of the polyesterpolyol is 3000-6000 (col 2 line 29). "Golf ball" paint is merely a future intended use for the paint.

Claims 1-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Patzschke '822 in combination with Iwami '667.

Patzschke discloses applicant's coating material, but does not suggest specific substrates.

Iwami teaches similar polyesterpolyol + polyisocyanate coatings are favorable on golf balls. It would have been obvious to place Patzschke's coating on any substrate – including golf balls. The environmental advantages of Patzschke's reduced solvent coatings would manifest themselves on any substrate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

5/26/05

DAVID J. BUTTNER
PRIMARY EXAMINER

